



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/663,007

09/16/2003

Alex Dolgonos

18894-17

1755

7590

08/21/2007

John S. Beulick  
Armstrong Teasdale LLP  
Suite 2600  
One Metropolitan Square  
St. Louis, MO 63102

EXAMINER

HO, HUY C

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

08/21/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/663,007

Applicant(s)

DOLGONOS, ALEX

Examiner

Huy C. Ho

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Argument*

1. Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.
2. In response to applicant's arguments, the recitation "tracking" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. **Claims 1, 4-23** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Saito (EP 1148671)** and further in view of **Herz et al. (2007/0166003)**.

**Consider claim 1**, (currently amended) Saito discloses a method of broadcasting information and data files to mobile units (see the abstract), comprising ~~steps of~~:

(a) receiving, through a bi-directional wireless network, a data request from a requesting mobile unit, the data request including identification information for the requesting mobile unit (**figure 1, the abstract, pars [5]-[6], [11], [18], [22]-[23], [45], [70], [78]**);

(b) associating the data request with a digital data file (**the abstract, pars [7], [21]-[22]**);

(c) broadcasting the digital data file together with identification data for the requesting mobile unit over a download channel on a broadcast network that has a plurality of broadcast channels and an overlapping coverage area with the bi-directional wireless network (**figure 1, pars [7], [11], [21]-[24], [76]-[77]**);

(d) simultaneously with step (c), broadcasting on at least one broadcast channel of the broadcast network other than the download channel a media signal for real-time reception by mobile units tuned to the at least one other broadcast channel (**paragraph [21], discussing the broadcast station provides a channel for music delivery and another channel for various types of radio programs and television programs**);

(e) receiving the identification data at the requesting mobile unit, determining if the identification

data corresponds to the requesting mobile unit, and if so, receiving and storing the digital data file at the requesting mobile unit for future use (pars [44]-[45], [47], [64]-[68]); and

(f) receiving media signal broadcast on at least one broadcast channel of the broadcast network other than the download channel for real-time reception at the requesting mobile unit (see pars [10], [47]-[48], where Saito discusses a mobile communication terminal comprising a first receiving means for receiving first information broadcast from a broadcast station, a second receiving means for receiving second information delivered from information delivery device)

Saito does not specifically show simultaneously receiving. Herz discloses simultaneously receiving (see paragraphs [10]-[12], [23], [26], [54], describing multiple broadcast programs being concurrently captured and playback or stored in memory of a device for future use). Since both Saito and Herz teach wireless communication system for distribution information, it would have therefore been obvious to one skilled in the art to modify Saito teaching, and having simultaneously receiving, as taught by Herz, to achieve a system and method for concurrently capture full region of spectrum of selectable radio frequencies as discussed by Herz (see paragraphs [2]-[12]).

Consider claim 16, Saito teaches a mobile unit (see figure 10, pars [44]-[50]), comprising:  
a bi-directional communications system for receiving and sending transmissions from and to a wireless bi-directional communications network (see the abstract, figure 10, pars [9], [44], [46]);  
a first broadcast receiver system for:

(i) receiving a real time broadcast transmission over a selected one of a plurality of selectable broadcast channels from a broadcast network having a coverage area overlapping with the bi-directional communications network (see figures 10 and 11, pars [19]-[21], [44]-[48]), and

(ii) receiving the data file from the broadcast network through the first broadcast receiver system and storing the data file in the storage, the selected one broadcast channel and the download channel being different channels (pars [10], [44]-[45]);

a storage (figure 10, pars [45]);

a user output device selected from the group consisting of a speaker and a display (figure 10, pars [45]-[47], [69]); and

a processor connected to the communications systems, the storage and the user output device (see figures 10 and 11, pars [45]) for:

(i) sending a request for a playable media file through the bi-directional communications system to the wireless bi-directional communications network, the request including information identifying the mobile unit (the abstract, pars [9], [44]-[50]), and

(ii) receiving a data file over a download channel from the broadcast network through the first broadcast receiver system and storing the data file in the storage, the real time broadcast transmission from the broadcast network through the first broadcast receiver system and generating a corresponding real time output on the user output device in response thereto (pars [44]-[45], [47], [64]-[68]);

Saito does not specifically show at the same time receiving. Herz discloses at the same time receiving (see paragraphs [10]-[12], [23], [26], [54], describing multiple broadcast programs being concurrently captured and playback or stored in memory of a device for future use). Since both Saito and Herz teach wireless communication system for distribution information, it would have therefore been obvious to one skilled in the art to modify Saito teaching, and having at the same time receiving, as taught by Herz, to achieve a system and method for concurrently capture full region of spectrum of various selectable radio frequencies as discussed by Herz (see paragraphs [2]-[12]).

Consider claim 18, (original) a method for tracking reception information for a wireless subscriber unit, comprising:

Saito discloses:

(a) receiving at a subscriber unit a plurality of selectable broadcast signals broadcast over a plurality of selectable channels by a wireless broadcast network (pars [6]-[8], [10], [47]);

(b) storing at the subscriber unit usage information about use by the subscriber unit of the wireless network (pars [35], [37], [40], discussing billing data is stored in a storing unit, counting table storing unit for storing number of delivery operation, this includes log data, information of delivery operation of songs); and

(c) transmitting the stored usage information from the subscriber unit to a bi-directional wireless communications network that has an overlapping coverage area with the broadcast network (pars [5], [6], [11]-[13], [18], [22], [23], [45], [70], [78], describing information includes terminal ID information, destination ID, song ID and channel information).

Saito does not specifically show over time. Herz discloses over time (see the abstract, pars [13], [21], [23]-[24], [51], where Herz discusses signals are transmitted and identified by channel and time).

Since both Saito and Herz teach wireless communication system for distribution information, it would have therefore been obvious to one skilled in the art to modify Saito teaching, and over time, as taught by Herz, to improve the personal radio system (see paragraphs [2]-[12]).

**Consider claim 4, (original)** The method of claim 1 Saito, as modified by Herz, further discloses prior to step (a), a step of broadcasting on the at least one other broadcast channel a prompt to encourage users of the mobile units to submit data requests for the digital data file to the bi-directional wireless network (see par [21], [32]).

**Consider claim 5, (original)** The method of claim 4 Saito, as modified by Herz, further discloses wherein the prompt includes information encouraging the users of the mobile units to contact a specified address associated with the bi-directional wireless network to request the digital data file (pars [19]-[20], [22]-[24]).

**Consider claim 6, (original)** The method of claim 5 Saito, as modified by Herz, further discloses wherein the bi-directional wireless network is a cellular network and the specified address is a telephone

number (pars [11], [19]-[20], [22]-[24]).

**Consider claim 7, (original)** The method of claim 6 Saito, as modified by Herz, further discloses wherein the data request includes the telephone number and in step (b) the telephone number is used as identifying information to associate the data request with the digital data file (pars [11], [19]-[20], [22]-[24]).

**Consider claim 8, (original)** The method of claim 4 Saito, as modified by Herz, further discloses wherein the prompt includes information causing a real-time aural message over a speaker at receiving mobile units (pars [47]-[50], [66]).

**Consider claim 9, (original)** The method of claim 4 Saito, as modified by Herz, further discloses including receiving data requests from a plurality of requesting mobile units only for a finite predetermined duration after broadcasting the prompt (par [68]), the data requests each including identification information for the respective requesting mobile units, and in step (c) the digital data file is broadcast together with identification data for the requesting mobile units for which data requests were received during the finite predetermined duration (pars [7], [11], [21]-[24], [76]-[77]).

**Consider claim 10, (original)** The method of claim 1 Saito, as modified by Herz, further discloses wherein the data request includes identifying information for the digital data file, and including, between steps (b) and (c), transmitting the digital data file from a data file storage to a broadcast location for subsequent broadcast over the download channel (pars [7], [11], [21]-[24], [76]-[77]).

**Consider claim 11, (original)** The method of claim 1 Saito, as modified by Herz, further discloses including, after step (a) and prior to step (c) transmitting through the bi-directional wireless network to the requesting mobile unit information identifying the download channel (pars [29]-[32]).

**Consider claim 12, (currently amended)** The method of claim 1, Saito, as modified by Herz, discloses wherein the broadcast network includes a plurality of terrestrial OFDM Orthogonal Frequency



Division Modulation (OFDM) transmitters arranged as a single frequency network (**the abstract, pars [3], [12]-[13], [23]**).

**Consider claim 13, (original)** The method of claim 12 Saito, as modified by Herz, discloses wherein the broadcast network broadcasts digital audio signals and the data file is a digital audio file (**par [121]-[122]**).

**Consider claim 14, (original)** The method of claim 13 Saito, as modified by Herz, discloses wherein the digital audio file in an MP3 file (**par [130]**).

**Consider claim 15, (currently amended)** The method of claim 1 Saito, as modified by Herz, further discloses including receiving from the plurality of the mobile units over the bi-directional wireless network information about usage by the mobile units of the broadcast network, including information about channels tuned to by the mobile units and length of usage of the tuned to channels (**pars [47], [55], [68]**).

**Consider claim 17, (original)** The mobile unit of claim 16 Saito, as modified by Herz, further discloses wherein the first broadcast receiver system is a terrestrial broadcast receiver, and the mobile unit also including a satellite receiver system for (i) receiving a real time broadcast transmission over a selected one of a plurality of selectable satellite broadcast channels from a satellite network having a coverage area overlapping with the bi-directional communications network, and (ii) receiving a data file over a satellite download channel from the satellite network, the selected one satellite broadcast channel and the satellite download channel being different channels (**pars [7], [11], [21]-[24], [76]-[77], [114]**);

wherein the processor is configured for receiving the data file through one of the first broadcast receiver system and the satellite receiver system and storing the data file in the storage while at the same time receiving the real time broadcast transmission through one of the first broadcast receiver system and the satellite receiver system and generating a corresponding real time output on the user output device in response thereto (**figures 10 and 11, pars [10], [45], [47]-[48]**,

**Consider claim 19, (original)** The method of claim 18 Saito, as modified by Herz, further discloses wherein the usage information is transmitted to the bi-directional wireless communications network at predetermined intervals (par [27]).

**Consider claim 20, (original)** The method of claim 18 Saito, as modified by Herz, further discloses wherein the usage information is transmitted to the bi-directional wireless communications network upon the subscriber unit receiving instructions over one of the bi-directional wireless communications network and the wireless broadcast network ([5], [6], [11]-[13], [18], [22], [23], [45], [70], [78]).

**Consider claim 21, (original)** The method of claim 18 Saito, as modified by Herz, further discloses wherein the bi-directional wireless communications network includes a plurality of base units connected to a coordinating hub, the base units having associated coverage areas for communicating with the subscriber unit as it moves through a coverage area of the bi-directional wireless communications network (pars [5], [6], [11], [17], [18], [22], [23], [45], [70], [78]), the bi-directional wireless communications network including a dedicated control channel through which network administration information is substantially continuously communicated between the subscriber unit and the bi-directional wireless communications network (pars [19]-[20]), wherein in step (c) the stored usage information is transmitted through the dedicated control channel (pars [7], [11], [21]-[24], [76]-[77]).

**Consider claim 22, (original)** The method of claim 21 Saito, as modified by Herz, further discloses including receiving through the control channel stored usage information from a plurality of subscriber units, and compiling the stored usage information at the coordinating hub (pars [35], [37], [40], [5]-[6], [11], [18]-[20], [22]-[23], [45], [70], [78]).

**Consider claim 23, (original)** The method of claim 18 Saito, as modified by Herz, discloses wherein the usage information includes identification of channels audited by the subscriber unit and the time periods during which the identified channels were audited (pars [12]-[13], [20]-[21], [42]-[43]).


*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy C. Ho whose telephone number is (571) 270-1108. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on 571-272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

\*\*\*

  
DUC M. NGUYEN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600